



Atty. Dkt. No. 084335/0123

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: **Toshio OTA et al.**
Title: **PRIMERS FOR SYNTHESIZING FULL LENGTH cDNA
CLONES AND THEIR USE**
Appl. No.: **09/629,469**
Filing Date: **July 28, 2000**
Examiner: **Carolyn Smith**
Art Unit: **1631**

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**RESPONSE TO RESTRICTION REQUIREMENTS AND
PRELIMINARY AMENDMENT**

Commissioner for Patents
Washington, D.C. 20231

Sir:

This responds to the Office Action mailed October 21, 2002 in the above-identified application. Enclosed herewith is a Petition for a two-month extension of time to extend the time to respond to January 21, 2003. Should such a request be deficient or absent or if there are any other deficiencies, consider this paragraph such a request and authorization to charge the appropriate fee under 37 C.F.R. §§ 1.16 to 1.18 to Deposit Account No. 19-0741.

Response to Restriction Requirements

In response to the first Restriction Requirement, Applicants hereby elect, without traverse, Group II, comprising claims 2-5, 8, 11-13, 15, and 18, for prosecution in the subject application. In response to the sequence restriction, Applicants hereby elect for examination, with traverse, SEQ ID NO. 10847. Applicants, of course, reserve the right to file a divisional application covering the subject matter of the non-elected claims and sequences.

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01 FC:1202
02 FC:1203

108.00 OP
280.00 OP

Restriction of Polynucleotide Sequences

In response to the sequence restriction, Applicants submit that the pending sequence restriction is improper and respectfully request reconsideration and withdrawal of the restriction.

The Examiner asserts that "the multitude of sequence submissions of examination has resulted in an undue search burden if more than one nucleic acid sequence is elected..." Applicants submit that this restriction is in violation of MPEP § 803.04, which states that "normally ten (10) sequences constitute a reasonable number for examination purposes." This is true even if each nucleotide sequence is an independent and distinct invention under 35 U.S.C. § 121. The Commissioner has decided *sua sponte* to waive the requirements of 37 CFR §1.141 *et seq.* and to permit the claiming of a reasonable number of nucleotide sequences in an application, thereby to "aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office."

Accordingly, Applicants elect SEQ ID NO. 702, 6233, 10847, and 10848. These sequences are related because the nucleotide sequence disclosed in SEQ ID NO. 10847 encodes the amino acid sequence disclosed in SEQ ID NO. 10848. Furthermore, the nucleotide sequences disclosed in SEQ ID NO. 702 and 6233 are the 5' and 3' partial sequences, respectively, of the nucleotide sequence of SEQ ID NO. 10847.